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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,650	09/28/1999	PETER M. MANSOUR	40062.7US01	3018

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EXAMINER

LEWIS, CHERYL RENE A

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/407,650

Applicant(s)

Mansour et al.

Examiner

Cheryl Lewis

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply.

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 September 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 2177

### III. DETAILED ACTION

1. Claims 1-34 are presented for examination.

#### *Drawings*

2. The drawings are objected to because they fail to show necessary textual labels of features or symbols in <sup>Figures 1-6</sup> Figure 1 as described in the specification. For example, placing a label, "client/server network system", with element 20 of Figure 1 and corresponding labels for element 34 of Figure 2; elements 102, 107, 109, 111, 113, 115 and 27 of Figure 3; element 200 of Figure 4; elements 108, 109, 110, 112, 126, 128, 134, 136, 140, 146, and 148 of Figure 5; and element 300 of Figure 6, would give the viewer necessary detail to fully understand this element at a glance. Also, provide labels for figures 3 and 4, elements 302-322 and figure 5, elements 316 and 322. A *descriptive* textual label for *each numbered element* in these figures would be needed to fully and better understand these figures without substantial analysis of the detailed specification. Any structural detail that is of sufficient importance to be described should be shown in the drawing. Optionally, applicant may wish

*Thyler  
Jas*

Art Unit: 2177

to include a table next to the present figure to fulfill this requirement. See 37 CFR 1.83. 37 CFR 1.84(n)(o) is recited below:

"(n) Symbols. Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

(o) Legends. Suitable descriptive legends may be used, or may be required by the Examiner, where necessary for understanding of the drawing, subject to approval by the Office. They should contain as few words as possible."

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2177

4. Claims 1, 3, 4, 7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Furusawa et al. (Pat. No. 4,663,736 filed 12/11/1984, hereinafter Furusawa).

5. Regarding Claim 1, Furusawa teaches a file deletion system in a file unit.

The method and associated system for a file deletion system in a file unit as taught or suggested by Furusawa includes:

marking folders containing messages to be retained with a first flag (col. 3, lines 27-43); marking folders having messages to be deleted with a second flag (Abstract, lines 1-14); and deleting messages contained within the folders having the second flag marked and the first flag unmarked (Abstract, lines 1-14).

6. Regarding Claim 3, Furusawa teaches marking folders having messages to be deleted (Abstract, lines 1-14), placing messages into folders, the messages being contained within individual folders (col. 3, lines 27-43).

7. Regarding Claim 4, Furusawa teaches marking folders having messages to be deleted with a second flag in response to placing messages into folders (Abstract, lines 1-14, col. 3, lines 27-43).

8. Regarding claim 7, Furusawa teaches copying or moving messages from one folder to another folder (Abstract, lines 1-9, *reset code to a set code*).

9. Regarding Claim 9, Furusawa teaches removing the second flag from the folders to unmark the folders (Abstract, lines 1-9, *reset code to a set code*).

Art Unit: 2177

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a

Art Unit: 2177

later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103<sup>®</sup> and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 2, 5, 6, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable Furusawa et al. (Pat. No. 4,663,736) as applied to claim 1 above, and further in view of Miron (Pat. No. 6,401,239 B1 filed 3/22/1999).

13. Regarding Claim 2, Furusawa does not expressly teach a client device.

Miron teaches a system and method for quick downloading of electronic files.

The method and associated system for quick downloading of electronic files as taught or suggested by Miron includes:

marking by the client device folders containing messages (col. 6, lines 33-58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the file unit method of Furusawa with the electronic file method of Miron because Miron's electronic file method enables transferring and downloading a file from a first computer to a second computer, while the first computer has a first version of a file and a second version of the file exists on the second computer.

14. Regarding Claim 5, Miron teaches downloading messages from a server to folders on the client device (col. 6, lines 35-58, col. 11, lines 1-54).

15. Regarding Claim 6, Miron teaches downloading messages from the server, connecting the client device to the server (col. 11, lines 1-54, col. 12, lines 1-63).

Art Unit: 2177

16. Regarding Claim 8, Miron teaches disconnecting the client device from a server (col. 9, lines 46-62).

17. Regarding Claim 10, Miron teaches marking folders having messages to be deleted with a second flag after connecting the client device to a server (col. 9, lines 39-62).

18. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable Furusawa et al. (Pat. No. 4,663,736) as applied to claim 1 above, and further in view of Salisbury (Pat. No. 6,330,573 B1 filed 8/31/1998, hereinafter Salisbury).

19. Regarding Claim 11, Furusawa does not expressly teach a hierarchy of folders.

Salisbury teaches maintaining document identity across hierarchy and non-hierarchy file systems.

The method and associated system for maintaining document identity across hierarchy and non-hierarchy file systems as taught or suggested by Salisbury includes:

getting a list of folder's sub-folders to recursively parse all the folders in the hierarchy (col. 14, lines 1-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the file unit means of Furusawa with the file method of Salisbury because Salisbury's file method enables translating between two incompatible document management systems whereby the identity of a document is maintained.



Art Unit: 2177

20. Claims 12-14, 16-22, 24-29, and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nitta et al. (Pat. No. 6,154,764 filed 7/9/1997, hereinafter Nitta) and Furusawa et al. (Pat. No. 4,663,736).

21. Regarding Claims 12, 20, 21, and 27, Nitta teaches on-line forum-type electronic conference system maintaining consistency of messages.

The method and associated system for on-line forum-type electronic conference system maintaining consistency of messages as taught or suggested by Nitta includes:

indicating folders containing messages to be retained with an off-line flag (col. 5, lines 35-64); indicating folders including messages to be deleted (col. 4, lines 32-45); and deleting messages contained within the folders and the off-line flag unmarked (col. 4, lines 32-45).

Nitta does not expressly teach a cleanup flag.

Furusawa teaches folders including messages to be deleted (Abstract, lines 1-3) with a cleanup flag (Abstract, lines 1-5, *deletion key*), a set module marking folders (figure 1(A) element 11, *execution key*), an erase module (figure 1(A) element 7, *Deletion Key (DEL)*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the electronic message system of Nitta with the file unit method of Furusawa because Furusawa's file unit enables deleting a particular message in a file, the deletion of the message is accomplished for those messages with a deletion set code in a file directory displayed on a screen.

Art Unit: 2177

22. Regarding Claims 13 and 28, Furusawa teaches before marking folders having messages to be deleted, placing into folders, the messages being contained within individual folders (Abstract, lines 1-14, col. 3, lines 27-53).
23. Regarding Claims 14 and 29, Furusawa teaches marking folders having messages to be deleted with a cleanup flag in response to placing messages into the folders (Abstract, lines 1-14).
24. Regarding Claims 16, 22, and 31, Furusawa teaches copying or moving messages from one folder to another folder (Abstract, lines 7 & 8, *change a deletion set/reset code*).
25. Regarding Claims 17, 24, 25, and 32, Nitta teaches deleting messages in response to disconnecting/connection the client device from the server (col. 5, lines 18-52).
26. Regarding Claims 18 and 33, Furusawa teaches after deleting messages, removing the cleanup flag from the folders to unmark the folders (Abstract, lines 1-14).
27. Regarding Claims 19, 26, and 34, Nitta teaches getting a list of folder's sub-folders to recursively parse all the folders in the hierarchy (col. 5, lines 45-64).
28. Claims 15, 23, and 30 rejected under 35 U.S.C. 103(a) as being unpatentable Nitta et al. (Pat. No. 6,154,764) and Furusawa et al. (Pat. No. 4,663,736) as applied to claims 12, 20, and 27 above, and further in view of Miron (Pat. No. 6,401,239).
29. Regarding Claim 15, 23, 30, Nitta does not expressly teach downloading messages from a server to folders on the client device.

Art Unit: 2177

Miron teaches downloading messages from a server to folders on the client device  
(Abstract, lines 1-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the electronic message means of Nitta's system with the electronic file means of Miron because Miron's electronic file means provides a download manager, wherein the download manager transfers a delta file from a server computer to a client computer.

*Other Prior Art Made of Record*

30. A. Boyer et al. (6,401,112 B1) discloses a method and apparatus for synchronizing an email client on a portable computer system with an email client on a desktop computer;

B. Elson (6,216,122 B1) discloses an electronic mail indexing folder having a search scope and interval;

C. Fleming, III (6,249,805 B1) discloses a method and system for filtering unauthorized electronic mail messages; and

D. Picard et al. (6,233,318 B1) discloses a system for accessing multimedia mailboxes and messages over the internet via telephone.

Art Unit: 2177

*Conclusion*

31. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

*Name of Contact*

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is 703-305-8750.

The examiner can normally be reached on Mon-Thur from 6:30 to 3:00 pm.

The fax phone numbers for the organization where the application or proceeding is assigned are as follows:

(703) 746-7238 (After Final Communication)

or:

(703) 746-7239 (Official Communications)

(703) 746-7240 (For Status inquiries, draft communication)

any/or:

(703) 746-5651 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.)

Any inquiry of a general nature of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Application/Control Number: 09/407,650

Page 12

Art Unit: 2177

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington, VA., Fourth Floor (Receptionist).

A handwritten signature in black ink, appearing to read "Cheryl Lewis", written over a horizontal line.

Cheryl Lewis

Patent Examiner

September 23, 2002